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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,341	10/11/2000	Peter Jenkner	198277US0 DIV	7038

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/685,341

Applicant(s)

JENKNER ET AL

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29,30,39,41,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29,30,39,41,43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of: *
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/984,162.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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As a means of overcoming the rejections under 35 U.S.C 102 in view of Akamatsu, Applicant has incorporated the limitations of claims 40 and 42 in claims 39 and 41 respectively. Applicant has also removed mention of the embodiment wherein the catalyst is only a weak acid. It is noted, however, that the latter change is all that would have been necessary to overcome the rejection as the aforementioned reference does not contemplate whatsoever the utilization of an alkaline catalyst. (Indeed, claims 40 and 42 should also have been rejected because they only limit those embodiments of the claimed invention wherein a weak base serves as the catalyst. That is, these claims, insofar as they were dependent from claims 39 and 41 would still have disclosed the embodiment for which an acid catalyst was employed.)

At the same time, the Examiner has located yet another reference that anticipates at least some of the claims, including the embodiment where the hydrolysis catalyst is an amine compound, for the reasons set forth *infra*. Original claim 41, on the other hand, is not anticipated by the new reference hence it is submitted that Applicant could rewrite claim 41 in its original form (minus mention of the acid catalyst of course) and compose a new claim reciting all of the same limitations as cancelled claim 42.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 39, 43, and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamashita et al., U.S. Patent # 6,329,490. Yamashita discloses a polyhedral perfluoroalkyl group-functionalized organosilicon compound and a method for its use. Said compound is prepared by the homopolymerization or copolymerization of the compounds (IV), (V), and (VI) at the bottom of column 4. The homopolymerization/copolymerization products derived from these precursors are generically represented by formulae (I), (II), and (III) also in column 4. Consistent with the instant invention, the preferred starting materials of Yamashita's invention are those wherein X1 and X2 denote, among others $-\text{CH}_2-$, $-\text{O}-$, or $-\text{S}-$, (column 5, lines 1-2) and Y symbolizes preferably a methoxy-, ethoxy-, or chloro- group (column 5, lines 9-11). Polymerization of said materials is carried out in the presence of a basic catalyst such as a metal hydroxide or an amine (column 7, lines 24-43) with a water to silane ratio of 3:1 (column 7, lines 61-62) over a period of 1 to 72 hours (column 8, lines 29-33) at between 10° and 150° C in an alcohol solvent (column 8, lines 15-16).

The organosilicon solution is applied to a substrate surface only after polymerization takes place according to the methodology in Example 12 bridging columns 18 and 19. Although a silicon wafer is coated therein, it is also lamented that the product may be coated onto glass fibers (column 9, lines 40-42). Therefore, claims 43 and 44 are also anticipated.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamashita et al., U.S. Patent # 6,329,490. Inasmuch as one of ordinary skill in the art will appreciate that glass fibers are sometimes used as fillers in polymer compositions, the subject matter of claims 29 and 30 is at least obvious.

Priority

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita, U.S. Patent # 6,329,490 in view of Akamatsu, U.S. Patent # 6,337,133 or Ona et al. U.S Patent # 5,489,328. Yamashita does not express disclose the employment of the fluoroalkyl-substituted organosilicon condensate as a coating material for buildings. Akamatsu and Ona, on the other hand, reveal that this class of materials has demonstrated utility for this purpose. (Claim 41 is not anticipated by either Akamatsu or Ona because they don't describe the same method for preparing the condensate. Yamashita discloses the same synthetic approach but not the end use. Together, however, they render claim 41 obvious.)

Priority

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

April 22, 2003

A handwritten signature in cursive script, reading "Robert A. Dawson". The signature is fluid and elegant, with a long, sweeping underline.

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700